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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/687,412	10/15/2003	Kenichi Kusunoki	15468-005001	8605
20985	7590	10/06/2004	EXAMINER	
FISH & RICHARDSON, PC			JONES, DAVID B	
12390 EL CAMINO REAL			ART UNIT	
SAN DIEGO, CA 92130-2081			PAPER NUMBER	

3725

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,412

Applicant(s)

KUSUNOKI ET AL.

Examiner

David B Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 11-13 and 22 is/are allowed.
- 6) ☒ Claim(s) 15-21 and 23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 15-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-259,752. Claims 15-21 are product-by-process claims. Even though product-by-process claims are limited by and defined by a process; determination of **patentability is based on the product** itself. Hence the patentability of a product-by-process claim does not depend on its method of production. If the product limitations in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. The patent office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature then when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

In this case the prior art reference to JP '752 teaches the claimed **product** of a fuel cell composed of a great number of convex sections. In that this is the only limitation on the **product** and in that the prior art teaches the claimed limitation, patentability is precluded under 35 USC 102(b).

2. Claims 1-5, 11-13, and 22 allowed.

3. Applicant's arguments filed 07/12/2004 have been fully considered but they are not persuasive. As recited in the last office action and as recited supra, the product-by-process claim (claims 15-21 and 23) is a peculiar type of claim and is given a lesser burden of proof for making a case of unpatentability. In the instant case the prior art

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teaches the product limitations of claim 15-21 and 23. The method or process limitations for making the product are given no weight in these type claims even though they are drafted in terms thereof. Hence arguments that the prior art fails to show the claimed fluid used in the method, lacking the claimed ratio and viscosity, is of no weight in determining whether the product being claimed is met by the product of the prior art under the rules of practice for product-by-process claims. Hence, the product being met by the product of the prior art, patentability is precluded under 35 USC 102 (b).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. JONES whose telephone number is (703) 308-1887.

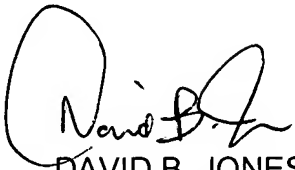
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

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In the event that the Applicant(s) wishes to communicate via Fax, the current central Fax number for the patent office is (703) 872-0906

DBJ



DAVID B. JONES
PRIMARY PATENT EXAMINER
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